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OFFICE OF PETITIONS

In re Application of: : ON PETITION
Johnson :
Filed: 14 September, 2000 :
Application No. 09/662,195 :
Docket No.:(None/formerly: 2000200-0003) :

This is a decision on the petition filed herein on 5 May, 2003, under 37 C.F.R. §1.137(a)¹ to revive the above-identified application.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)² (as to unintentional delay) must be submitted within two (2)

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee required by 37 C.F.R. §1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

² Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met

months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";

- (2) Thereafter, there will be no further reconsideration of this matter.
- (3) The Power of Attorney filed of record is acknowledged and accepted.

However, it is noted that the phone ((202) 261-1200) and FAX ((202) 261-1268) numbers set forth in that document are not operating numbers.

As a result, the phone ((202) 861-1200) and FAX ((202) 861-1268) numbers set forth on Petitioner's letterhead were used to complete the Office database.

If this is incorrect, Petitioner must notify the Office immediately.

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 12 August, 2002, with reply due (absent and extension of time) on or before Tuesday, 12 November, 2002;
- the application was deemed abandoned after midnight 12 November, 2002;
- no Notice of Abandonment was mailed before the instant petition was filed;
- Petitioner Eugene Berman (Reg. No. 22,587) details the financial demise of the former assignee, Supercritical Combustion Corporation (formerly known as Quantum Energy Corporation), and resulting in:

--a Chapter 7 bankruptcy filing by the former assignee (U.S. Bankruptcy Court, D.

by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

Mass. Case No. 02-18821-WWC) on 9 December, 2002;

--an auction by the Trustee in bankruptcy on 13 February, 2003, of this application and other properties of the bankrupt assignee; and

--final receipt of the Bill of Sale from the Trustee by present assignee Nanocluster Technologies LLC on 11 April, 2003;

- Petitioner acknowledges that the docket records of the former assignee's then-Counsel (Brenda Herschbach Jarrell (Reg. No. 39,233) reflect that the 12 August, 2002, final Office action was received by the then-Counsel;
- notably, Petitioner failed to file with the instant petition either the required fee (\$55.00) for the petition or the required reply:

--Petitioner apparently filed a petition to revive in the wrong case and sought to have the fee transferred, however that fee already has been returned; and

--Petitioner alleges that he does not have the 12 August, 2002, final Office action--it appears that, notwithstanding Petitioner's Power of Attorney, Petitioner failed to review the record in the instant matter or otherwise obtain a copy of the action before filing the instant petition. (A copy of the final Office action is enclosed.)

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁴

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.⁵ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁶

And the Petitioner must be diligent in attending to the matter.⁷ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁸))

Allegations as to Unavoidable Delay

The “delay” which precipitated the abandonment herein occurred between August and November 2002--before the bankruptcy filing by the former assignee.

To date, the record makes no showing of any action taken by the former assignee to advance the prosecution of the instant application prior to abandonment by way of replying to the 12 August, 2002, Office action.

Therefore, as to the delay in this matter, a delay is not “unavoidable” when there is no documentary support of the allegation or when an applicant simply permits the maximum extendable statutory period for reply to expire.⁹

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.¹⁰

⁵ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁶ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁷ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁸ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁹ See MPEP 711.03(c)(III)(C)(2).

¹⁰ *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term “unavoidable” “is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business”); *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."¹¹

As to the petition alleging unavoidable delay, Petitioner has failed to support the allegation and failed to provide the "reply." (Petitioner is reminded that a proper reply to the final Office action is not simply a reply under 37 C.F.R. §1.111 or §1.112.¹²)

Accordingly, in view of the failure of the "showing," the "reply" and the "fee" requirements to be met herein, the petition to revive as to unavoidable delay under 37 C.F.R. §1.137(a) must be and hereby is **dismissed**.

ALTERNATIVE VENUE

It appears that Petitioner is unable to make a showing of unavoidable delay surpassing that tendered heretofore, and, therefore, Petitioner's only alternative to irretrievable abandonment likely is to file a petition and fee as set forth at NOTE 1, above at pages 1 and 2, under 37 C.F.R. §1.137(b), and state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

Thus, Petitioner may wish to supplement his petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the "showing" burden is much less onerous.

Petitioner is cautioned that failure to submit such a petition 37 C.F.R. §1.137(b) timely may be viewed as intentional delay and an absolute bar to revival.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)¹³
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

¹¹ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

¹² The proper response to the final Office action (see: Fn. 1, item (1); MPEP 711.03(c)) must be in the form of: (a) an amendment *prima facie* placing the application in condition for allowance; (b) a Notice of Appeal; or (c) a request for continued examination (RCE) under 37 C.F.R. §1.114 (with fee and submission) or a continuing application.

¹³ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By FAX: (703) 308-6916
ATTN.: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", with a long, sweeping horizontal line extending to the right.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Encl: A copy of the 12 August, 2002, final Office action